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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/406,473  | 09/27/1999  | STEPHEN D. PACETTI   | 50623-00008         | 1646             |
| 7590 06/18/2009   |             |                      |                     |                  |
| CAMERON KERRIGAN<br>SQUIRE, SANDERS & DEMPSEY LLP<br>ONE MARTINE PLAZA<br>SUITE 300<br>SAN FRANCISCO, CA 94111-3492 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| KOHARSKI, CHRISTOPHER   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3763  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 06/18/2009  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* STEPHEN D. PACETTI

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Appeal No. 2008-006373  
Application 09/406,473  
Technology Center 3700

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Mailed: June 18, 2009

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Before DALE M. SHAW, *Chief Appeals Administrator*

ORDER REMANDING TO EXAMINER

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This application was electronically received by the Board of Patent Appeals and Interferences on August 28, 2008. Upon review of the application, it has been determined that a remand to Examiner, via the Office of the Director of the Technology Center, is necessary to consider the following issues and to take necessary corrective action.

### APPEAL BRIEF, APPEALED CLAIMS

Appellant has not appealed all rejected claims. Specifically, a review of the Grounds of Rejection on the record finds that rejections are outstanding for the following pending claims: 139-154. The rejected claims that have not been appealed and/or argued for appeal are claims 139-141, 144-146, and 148-154.

### DISCUSSION

The Board of Appeals and Interferences (Board), in *Ex parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf> (BPAI May 14, 2008) (precedential), held that in appeals where rejected claims are expressly withdrawn, or are implicitly withdrawn by not presenting arguments in support of patentability, the Board will remand (or return) the application to the Examiner with instructions to cancel the expressly or implicitly withdrawn claims. *See also Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8<sup>th</sup> ed. Rev. 7, Sept 2008).

### CONCLUSION

Accordingly, it is  
ORDERED that this application be returned to the Examiner to:

- 1) to have the appellant or the examiner enter a paper canceling claims 139-141, 144-146, and 148-154 and amending claims 142, 143 and 147 into independent form;
- 2) upon entry of the paper, to return the application to the Board for the consideration of appealed claims; and
- 3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/bar

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